

1 Tharan Gregory Lanier (State Bar No. 138784)  
tglanier@jonesday.com  
2 Michael C. Hendershot (State Bar No. 211830)  
mhendershot@jonesday.com  
3 JONES DAY  
1755 Embarcadero Road  
4 Palo Alto, CA 94303  
Telephone: (650) 739-3939  
5 Facsimile: (650) 739-3900

6 [Additional counsel identified on signature pages]

7 Attorneys for Defendant  
NXP USA, INC.

9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA  
11 OAKLAND DIVISION

13 IMPINJ, INC.,

14 Plaintiff,

15 v.

16 NXP USA, INC.,

17 Defendant.

Case No. 4:19-CV-03161-YGR

**NXP USA, INC.'S ELEMENTS OF  
PROOF**

Pursuant to Section 2(a)(i) of the Court’s Standing Order Re: Pretrial Instructions in Civil Cases (updated December 21, 2023), NXP USA, Inc. hereby submits the following statement of elements of proof for its defenses and counterclaims, including summaries of the evidence anticipated to prove them.

**1. Invalidity of U.S. Patent No. 9,633,302.**

NXP asserts as both a defense and as a counterclaim for declaratory judgment of invalidity that claims 1, 3, 4, and 7 of the ’302 patent are invalid in view of the prior art. NXP bears the burden of proving invalidity. To prove that claims 1, 3, 4, and 7 of the ’302 patent are invalid, NXP must show that (1) a single prior art reference includes each and every limitation of each of claims 1, 3, 4, and 7, either expressly or inherently, see, e.g., *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (“A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim.”), or (2) the invention of claims 1, 3, 4, and 7 would have been obvious to a person of ordinary skill in the art in view of a single prior art reference or combination of prior art references, 35 U.S.C. § 103; see also *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Graham v. John Deere Co.*, 383 U.S. 1 (1966); U.S.D.C. N.D. Cal. Model Patent Jury Instructions, Instruction B.4, 4.3b (Alternative 2).

NXP asserts that claims 1, 3, 4, and 7 of the ’302 patent are anticipated by or are obvious in view of U.S. Patent No. 7,578,053 (“Nishigawa”) alone or in combination with prior art reference U.S. Patent No. 6,246,327 (“Eberhardt”). NXP also asserts that the invention of claims 1, 3, 4, and 7 of the ’302 patent would have been obvious in view of prior art reference Eberhardt, in combination with U.S. Patent No. 6,184,581 (“Cornell”), U.S. Patent Application Publication No. 2011/0139501 (“Ching-san”), and/or “TOWARDS A BETTER UNDERSTANDING OF UNDERFILL ENCAPSULATION FOR FLIP CHIP TECHNOLOGY: PROPOSED DEVELOPMENTS FOR THE FUTURE,” Ken Gilleo, et al., Microelectronics International (1999) (“Gilleo”).

**Claim 1:** To demonstrate that claim 1 of the ’302 patent is anticipated by Nishigawa, or is obvious in view of Nishigawa alone or in combination with Eberhardt, or is obvious in view of

1 Eberhardt in combination with Cornell, Ching-san, and/or Gilleo, NXP must show that the prior  
2 art references include or render obvious the following limitations:

- 3 i. [1-pre] A Radio Frequency Identification (RFID) integrated circuit (IC)  
4 comprising:
- 5 ii. [1-a] an IC substrate;
- 6 iii. [1-b] a first antenna contact disposed on, and confined within a perimeter of, a  
7 surface of the IC substrate; and
- 8 iv. [1-c] a second antenna contact disposed on, and confined within the perimeter of,  
9 the surface of the IC substrate; wherein:
- 10 v. [1-d] the first and second antenna contacts are separated by a channel having a first  
11 end, a second end opposite the first end, and a center between the first end and the  
12 second end;
- 13 vi. [1-e] the channel spans a majority of a width of the IC substrate;
- 14 vii. [1-f] a first transverse channel cross-section at the first end is substantially the  
15 same size as a second transverse channel cross-section at the second end and  
16 substantially larger than a third transverse channel cross-section at the center; and
- 17 viii. [1-g] the channel is shaped to facilitate a fluid flow from the center to the first and  
18 second ends.

19 **Claim 3:** To demonstrate that claim 3 of the '302 patent is anticipated by Nishigawa, or  
20 is obvious in view of Nishigawa alone or in combination with Eberhardt, or is obvious in view of  
21 Eberhardt in combination with Cornell, Ching-san, and/or Gilleo, NXP must show that the prior  
22 art references include or render obvious the following limitations:

- 23 i. The RFID IC of claim 1, wherein the channel has a non-convex shape.

24 **Claim 4:** To demonstrate that claim 4 of the '302 patent is anticipated by Nishigawa, or  
25 is obvious in view of Nishigawa alone or in combination with Eberhardt, or is obvious in view of  
26 Eberhardt in combination with Cornell, Ching-san, and Gilleo, NXP must show that the prior art  
27 references include or render obvious the following limitations:

- 28 i. The RFID IC of claim 1, wherein the channel is substantially symmetric about at

1 least one plane orthogonal to the surface of the IC substrate.

2 **Claim 7:** To demonstrate that claim 7 of the '302 patent is anticipated by Nishigawa, or  
3 is obvious in view of Nishigawa alone or in combination with Eberhardt, or is obvious in view of  
4 Eberhardt in combination with Cornell, Ching-san, and Gilleo, NXP must show that the prior art  
5 references include or render obvious the following limitations:

- 6 i. [3-pre] The RFID IC of claim 1, wherein each of the antenna contacts includes:
- 7 ii. [3-a] a raised nonconductive structure; and
- 8 iii. [3-b] a conductive layer disposed on the raised nonconductive structure.

9 **Motivation to Combine References.** To the extent NXP contends the inventions of  
10 claims 1, 3, 4, and 7 of the '302 patent would have been obvious in view of the combination of  
11 Nishigawa and Eberhardt, or Eberhardt and Cornell, Ching-san, and/or Gilleo, NXP also must  
12 show there would have been some motivation for a person of ordinary skill in the art to combine  
13 the references to arrive at the inventions of claims 1, 3, 4, and 7.

14 To prove invalidity of claims 1, 3, 4, and 7 of the '302 patent, NXP may rely on the  
15 testimony of Dr. Vivek Subramanian; cross-examination testimony of Dr. Scott Thompson; the  
16 disclosures of the '302 patent, Eberhardt, Cornell, Ching-san, Gilleo, Nishigawa, and other prior  
17 art references reflecting the state of the art as of the effective filing date. NXP may also rely on  
18 relying on rebuttal testimony (of already disclosed witnesses), the scope of which will be  
19 determined by Impinj's response.

## 20 2. No Injunctive Relief.

21 Impinj bears the burden of proving entitlement to injunctive relief, and NXP does not bear  
22 any burden of proving that Impinj is not entitled to injunctive relief. To obtain injunctive relief,  
23 Impinj must show that (1) it has suffered irreparable injury; (2) legal remedies, such as money  
24 damages, are inadequate compensation for the injury; (3) the balance of hardships between the  
25 patentee and the infringer indicates that an equitable remedy is warranted; and (4) the public  
26 interest would not be harmed by the award of an injunction. *See eBay v. MercExchange, L.L.C.*,  
27 547 U.S. 388 (2006). To prove irreparable injury, Impinj must prove a "causal nexus" between  
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1 the alleged harm and the alleged infringement, meaning that the patented features actually impact  
2 consumers' decisions to purchase the accused products. *Apple Inc. v. Samsung Elecs. Co.*, 809  
3 F.3d 633, 639 (Fed. Cir. 2016). Because Impinj bears the burden of proving entitlement to  
4 injunctive relief, NXP will prevail on its defense of no injunctive relief by showing that Impinj  
5 has failed to prove any one of the required elements. NXP notes that injunctive relief is an  
6 equitable remedy, and thus, evidence solely directed to Impinj's claim for an injunction should  
7 not be presented to the jury.

8 To show that Impinj has not met its burden with respect to injunctive relief, NXP may rely  
9 on testimony of NXP witnesses, which may include Kurt Bischof, Lee Chastain, Ralf Kodritsch,  
10 Hermann Zach, Nigel Stott, Christian Zenz, Franz Amtmann, Roland Brandl, Ray Henling, Sai  
11 Rajen and David Haas; cross-examination testimony of Impinj's witnesses, which may include  
12 Christopher Diorio, Ronald Oliver, Jeffrey Dossett, and Drew Dannels; documentation  
13 concerning the design and marketing of the accused NXP products; documentation reflecting  
14 trends in and the state of the RFID IC market, competition, and the parties' respective  
15 performances; documentation concerning the parties' sales figures.

### 16 3. No Attorneys' Fees.

17 Impinj bears the burden of proving that attorneys' fees pursuant to 35 U.S.C. § 285 are  
18 available as a potential remedy in this case, and NXP does not bear any burden of proving that  
19 attorneys' fees are not available. To show that attorneys' fees are available as a potential remedy,  
20 Impinj must prove that this is an exceptional case. 35 U.S.C. § 285. Because Impinj bears the  
21 burden of proving availability of attorneys' fees, NXP will prevail on its defense of no injunctive  
22 relief by showing that Impinj has failed to prove that this case is exceptional.

23 To show that Impinj has not met its burden with respect to attorneys' fees, NXP may rely  
24 on testimony of NXP's and Impinj's fact and expert witnesses; the disclosures of the asserted  
25 patents and prior art references; documents concerning the design, function, and marketing of the  
26 accused NXP products; correspondence between the parties; and other filings and submission to  
27 the Court.  
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JONES DAY

By: /s/ Lisa L. Furby

Lisa L. Furby

Tharan Gregory Lanier  
(California State Bar No. 138784)  
tglanier@jonesday.com

Michael C. Hendershot  
(California State Bar No. 211830)  
mhendershot@jonesday.com

Gurneet Singh  
(California State Bar No. 333711)  
gsingh@jonesday.com

JONES DAY  
1755 Embarcadero Road  
Palo Alto, CA 94303  
Telephone: (650) 739-3939  
Facsimile: (650) 739-3900

Thomas W. Ritchie (admitted *pro hac vice*)  
(Illinois State Bar No. 6301954)  
twritchie@jonesday.com

Lisa L. Furby (admitted *pro hac vice*)  
(Illinois State Bar No. 6312855)  
lfurby@jonesday.com

John M. Michalik (admitted *pro hac vice*)  
(Illinois State Bar No. 6280622)  
jmichalik@jonesday.com

Timothy J. Heverin (admitted *pro hac vice*)  
(Illinois State Bar No. 6243107)  
tjheverin@jonesday.com

JONES DAY  
110 North Wacker Drive, Suite 4800  
Chicago, IL 60606  
Telephone: (312) 782-3939  
Facsimile: (312) 782-8585

Yury Kalish (admitted *pro hac vice*)  
(D.C. State Bar No. 1020172)  
ykalish@jonesday.com

Tracy A. Stitt (admitted *pro hac vice*)  
(D.C. State Bar No. 1015680)  
tastitt@jonesday.com

Robert Levent Herguner (admitted *pro hac vice*)  
(New York State Bar No. 5722228)  
rlherguner@jonesday.com

JONES DAY  
51 Louisiana Ave., N.W.  
Washington, D.C. 20001  
Telephone: (202) 879-3939

Facsimile: (202) 626-1700

T. Kaitlin Crowder (admitted *pro hac vice*)  
(Ohio State Bar No. 0095796)

Robert M. Breetz (admitted *pro hac vice*)  
(Ohio State Bar No. 0098968)

kcrowder@jonesday.com

JONES DAY

901 Lakeside Ave. E.

Cleveland, OH 44114

Telephone: (216) 586-7347

Facsimile: (216) 579-0212

Matthew J. Silveira

(California State Bar No. 264250)

JONES DAY

555 California Street, 26th Floor

San Francisco, CA 94104

Telephone: (415) 626-3939

Facsimile: (415) 875-5700

msilveira@jonesday.com

Attorneys for Defendant

NXP USA, INC.